

REMARKS:

Applicants have canceled claims 1, 4-11, and 14-20; amended claims 2 and 3 to be in independent form including all of the limitations in claim 1; and amended claims 12 and 13 to be in independent form including all of the limitations of claim 11. Claims 2, 3, 12, and 13 remain pending and under current examination.

In the Office Action the Examiner rejected claims 1, 4-11, and 14-20 under 35 U.S.C. § 102(e) as being anticipated by Sugino et al., European Patent Application No. 1 107 299 A2. The Examiner noted that claims 2, 3, 12, and 13 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Also, the Examiner provisionally rejected claims 1-20 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 15-25 of copending U.S. Application No. 10/808,298 ("the '298 application"). Entry of this Amendment will overcome the Examiner's provisional rejection of claims 1- 20, and will overcome the rejections under 35 U.S.C. § 102.¹

As a preliminary matter, Applicants remind the Examiner that two references cited on Form PTO 1449, date stamped October 21, 2004, were not initialed or crossed-out. Specifically, European Patent Application No. 0 981 156 A2, and European Search

¹ The Office Action contains statements characterizing the related art, case law, and the claims. Regardless of whether any such statements are specifically identified herein, Applicants decline to automatically subscribe to any statements in the Office Action.

Report in Application No. 04008108, dated August 5, 2004, were not marked as having been considered. Applicants respectfully request consideration of the references.

Rejection of Claims 1, 4-11, and 14-20 under 35 U.S.C. § 102(e):

Applicants traverse these rejections and deem them moot for the following reasons:

- (1) claim 1 has been canceled, and objected-to claims 2 and 3 now include all limitations recited in claim 1. Claims 2 and 3 are now in independent form;
- (2) claim 11 has been canceled, and objected-to claims 12 and 13 now include all limitations recited in claim 11. Claims 12 and 13 are now in independent form; and
- (3) claims 4-10 and 14-20 have been canceled.

As such, Applicants submit that the amendments have rendered the rejections under 35 U.S.C. § 102 moot.

Rejection of Claims 1-20 under Double Patenting:

Applicant respectfully traverses the nonstatutory double patenting rejection of claims 1-20 on the grounds that the Examiner has failed to establish that the claims define an obvious variation of the invention defined in claims '15-25 of the '298 application.

A double patenting rejection of the obviousness-type is "analogous to [a failure to meet] the nonobviousness requirement of 35 U.S.C. 103" except that the patent principally underlying the double patenting rejection is not considered prior art. *In re Braithwaite*, 379 F.2d 594, 154

USPQ 29 (CCPA 1967). Therefore, any analysis employed in an obviousness-type double patenting rejection parallels the guidelines for analysis of a 35 U.S.C. 103 obviousness determination. *In re Braat*, 937 F.2d 589, 19 USPQ2d 1289 (Fed. Cir. 1991); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985). ...

Any obviousness-type double patenting rejection should make clear:

(A) The differences between the inventions defined by the conflicting claims - a claim in the patent compared to a claim in the application; and

(B) The reasons why a person of ordinary skill in the art would conclude that the invention defined in the claim in issue is an obvious variation of the invention defined in a claim in the patent.

M.P.E.P. § 804. As discussed below, the Examiner has not met the burden of showing that a case of obviousness-type double patenting exists

In amended claims 2, 3, 12 and 13, Applicants require a manufacturing method comprising, for example, "providing a groove having a thickness equal to or larger than a finishing thickness on a first surface of a semiconductor wafer on which a semiconductor element is formed." This limitation was originally included in claims 1 and 11. The Examiner did not specifically mention this limitation, but merely stated that "the scope of claims 1 and 11 of the instant application is similar to that of the scope of claims 19-25" of the '298 application. Office Action at 2. As such, the Examiner fails to give "reasons why a person of ordinary skill in the art would conclude that the invention defined in a claim in issue is an obvious variation of the invention defined in the patent."

M.P.E.P. § 804. Thus, the Examiner has failed to establish that the claims define an obvious variation of the invention defined in claims 15-25 of the '298 application.

Similarly, in amended claims 2, 3, 12 and 13, Applicants require a manufacturing method comprising, for example, "reducing the thickness of the semiconductor wafer by processing a second surface opposite to the first surface of the semiconductor wafer onto which the PSA tape is affixed, so as to separate the semiconductor wafer into a plurality of semiconductor chips on which the semiconductor element is formed." The Examiner also failed to discuss this limitation, summarily dismissing the claims as discussed above. Here too, the Examiner has failed to establish that the claims define an obvious variation of the invention defined in claims 15-25 of the '298 application, and has thus not met the burden for showing that a case of obviousness-type double patenting exists. Applicants respectfully request that the provisional rejection of claims 1-20 under nonstatutory double patenting be withdrawn.

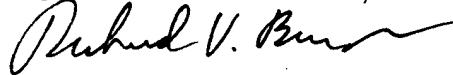
Conclusion:

In view of the foregoing amendments and remarks, Applicants respectfully request reconsideration and reexamination of this application and the timely allowance of pending claims 2, 3, 12, and 13.


Please grant any extensions of time required to enter this response and charge
any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.



Dated: June 23, 2005

By:  #27,432
Richard V. Burgujian
Reg. No. 31,744